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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/870,591	06/06/1997	HEINZ ESCH	08594327	7151

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EXAMINER

HENDRICKSON, STUART L

ART UNIT	PAPER NUMBER
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1754

45

DATE MAILED: 09/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/870591

Applicant(s)

Esch

Examiner

H. Jackson

Group Art Unit

1761

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 1/25/02
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 111; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 16, 17, 20 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 16, 17, 20 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 1754

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 16, 17 and 20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lagarde et al.

This is essentially the rejection made in the examiner's answer (incorporated by reference), noting that the intended use does not limit the product claimed. The DBP value is expected to be somewhat higher than the CTAB because DBP is a smaller molecule and thus more readily adsorbed. Column 13 teaches a particle size indicative of the claimed product.

Claims 16, 17 and 20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Johnson et al. '750.

This is essentially the rejection made in the examiner's answer (incorporated by reference), noting that the intended use does not limit the product claimed. The DBP value is expected to be somewhat higher than the CTAB since DBP is a smaller molecule and thus more readily adsorbed.

Applicant's arguments filed 6/25/02 have been fully considered but they are not persuasive. The Declaration is not persuasive since it is not a side-by-side comparison. The differences in the behavior in rubber could be due to some as yet unclaimed feature. It is not seen why an *indirect* comparison is made, rather than a direct comparison of the silicas. The new Declaration is only argument, and provides no new data. Differences must be unexpected, and be as a result of a claimed parameter. Therefore, it is easier to show a direct difference in a characteristic by side-by-side comparison than to rely upon indirect data of behavior in rubber. Instant ex. 1 and ex. 3 of Johnson both add silicate and sulfuric acid to make a pH of 8.5, thus the process is substantially

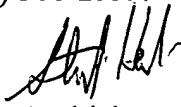
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the same. Column 13 of Lagarde further elucidates the 'less than 45 micron' filter teaching, to show a particle size in the claimed range. Both references are US Patents and thus are enabled. A rejection under 102/103 is not a 102 and a 103. It is a special class of rejection, used when one cannot tell if the material is the same. It is not a question of a thought process by the artisan to change something, which is the usual analysis of 'obviousness'. Lagarde is deemed to possess the claimed properties because it was made in a fashion similar to the claimed product, and has many of the same properties. Thus, all properties are taken to be possessed. Johnson show several examples with varying solids contents. Johnson ex. 1 has 135 minutes of process; instant ex. 1 has 150 minutes. Thus, one long stage is not materially different from two short stages adding up to close to the same amount of time. Lagarde merely uses a sieve of 45 microns; this is not the same as making all particle sizes less than 45 microns- see column 13.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (703) 308-2539.



Stuart Hendrickson
examiner Art Unit 1754